

AMENDMENT UNDER 37 C.F.R. § 1.111
Appln. No.: 09/042,666

35. (Amended) An optical wavelength conversion waveguide device as claimed in claim 3433, wherein said mode converter comprises a second harmonic generator.

36. An optical wavelength conversion waveguide device as claimed in claim 33, wherein the waveguide device lowers the OPG threshold by at least one order of magnitude as compared to a non-waveguide-form bulk device.

REMARKS

Applicant cancels claims 2 and 34; therefore, claims 1, 3-33, 35 and 36 are all the claims pending in the application.

The Examiner indicates that claims 14-28 are **allowed**, and that claims 2-4, 34 and 35 would be **allowable** if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The Examiner maintains the double-patenting rejections of claims 1, 5-13, 29-33 and 36 as being unpatentable over (i.e., obvious from) claims 1-8, 23 and 24 and the disclosure of U.S. Patent No. 6,154,310 (parent of this CIP). Also, the Examiner explains his position with regard to claims 31-33, namely that claim 31-33 would have been obvious in view of claims 1-3 of the parent application.

- AMENDMENT UNDER 37 C.F.R. § 1.111
Appln. No.: 09/042,666

Applicants respond by:

- amending claim 1 to include the limitation of the allowed claim 2,
- amending claim 33 to include the limitation of the allowed claim 34,
- canceling claims 2 and 34,
- amending claims 3 and 4 to depend on claim 1,
- amending claim 35 to depend on claim 33, and
- traversing the rejection of claims 29 and 30 as proposed above.

In view of the above amendments, claims 1, 2-28, 31-33, 35 and 36 should now be allowed.

Applicants cede that the scope of original claims 1 and 33 are, at least by equivalents, the same as that of the corresponding parent claims. Accordingly, Applicants amend these claims to incorporate limitations from allowable dependent claims.

With regard to **claims 29 and 30**, none of the claims of U.S. Patent No. 6,154,310 (parent of this CIP) recite the specific requirements for the optical parametric generation portion as defined therein. Therefore, it would not have been obvious to one of ordinary skill in the art to implement an optical parametric generation portion having the specific requirement recited in claims 29 and 30 of this CIP application into an ultrashort pulse generator as defined in claims 1-8, 23 and 24 of U.S. Patent No. 6,154,310.

In particular, the Examiner relies on the disclosure of U.S. Patent No. 6,154,310 “beginning at col. 5, line 24” alleging that the specific regimes of the optical parametric generation portion as recited in claims 29 and 30 are encompassed by the claims of U.S. Patent No. 6,154,310 (see Office Action, page 3). However, the Examiner’s argument is improper,

AMENDMENT UNDER 37 C.F.R. § 1.111
Appln. No.: 09/042,666

because a double patenting rejection can only be based on the claims of the parent application not the specification thereof.

On the other hand, if the Examiner is alleging that the specific implementations recited in claims 29 and 30 of this CIP application are “inherent” in the optical parametric generation portion of the ultrashort pulse generator as defined in, for example, claim 1 of U.S. Patent No. 6,154,310, then the Examiner cannot rely on the disclosure of either this CIP or U.S. Patent No. 6,154,310 as a basis for such an allegation. Thus, the double-patenting rejection of claims 29 and 30 is unsupported and should be withdrawn.

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



Stan Torgovitsky
Registration No. 43,958

SUGHRIE MION, PLLC
Telephone: (202) 293-7060
Facsimile: (202) 293-7860

WASHINGTON OFFICE



23373

PATENT TRADEMARK OFFICE

Date: November 18, 2003